

Application No. 10/619,101
Amendment Dated June 10, 2008
Reply to Office Action of Jan. 10, 2008

Applicant stated that there are reasons why the *Matthews* and *Hockey* references are not combinable.

Those reasons are set forth below.

As described in more detail below, Applicant and the Examiner discussed other clarifying amendments to independent claims 2 and 12 reflected in the List of Claims above.

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested. Claims 2 and 12 have been amended, no claims have been cancelled, and claims 2-21 are currently pending in the present application.

I. Amendments

During the interview, Applicant discussed with the Examiner the support for proposed amendments to the independent claims. Support for the addition of a submission of is found in paragraph 11, where it is the submission of the preliminary profile data that indicates the user's interest in joining one of the communities. Support for the addition of ascertains and controls is found in paragraph 11, where the "system is employed to ascertain and control the entrance of data." Applicant removed "the first filter tailored to said one of the plurality of communities" per a suggestion by the Examiner during the interview. Support for the addition of is created for the live user is found in paragraphs 12 and 13, where the profile is created for the user, not necessarily by the user. Support for the addition of data related to is found in paragraphs 8 and 15, where it is the data in the profiles of other users that is searched, and not necessarily the users. The addition of the flagging filter is configured to was a clarifying amendment made to delineate which component is configured to flag communications.

II. 35 U.S.C. § 103(a)

The Examiner rejected independent claims 2 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Matthews*, in view of *Sutcliffe*, and in further view of *Hockey*. Applicant respectfully traverses the Examiner's assertion that claims 2 and 12 are obvious in view of *Matthews*, *Sutcliffe*, and *Hockey*.

In general, claims 2 and 12 are directed to an apparatus and a method, respectively, for facilitating electronic collaboration in an environment having a plurality of communities, each of which has a plurality of users. Claims 2 and 12 as amended require "a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria, wherein the flagging filter is configured to flag communications for review prior to release to their intended recipient." While *Matthews* states that a group administrator may also have the authority to monitor interaction on message boards and/or to remove inappropriate content, *Matthews* does not disclose, suggest, or teach a system or method wherein a flagging filter flags communications between users based on a textual portion of the communications prior to release to their intended recipient.

As noted above with regard to the interview, the Examiner proffered that *Hockey* fills the deficiencies of *Matthews* by disclosing a system with the ability to flag communications prior to release to their intended recipient. *Hockey* discloses a system that changes a message's attributes so that it may not be delivered or opened, and/or may be placed in a quarantine zone for review by a system administrator. As proffered by the Examiner during the interview, this would allow the communication to be reviewed prior to release to its intended recipient.

The claim limitation set forth above, however, is not obvious in light of *Matthews* in view of *Hockey* because one of ordinary skill in the art cannot combine the elements in *Matthews* and *Hockey* in order to perform the function of the claimed limitation. As stated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007):

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovative the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Id. at 1741.

Hockey discloses a method for monitoring mail messages particularly for virus attacks and unsolicited commercial email ("spam"). See *Hockey*, abstract. The system described by *Hockey* attempts to accomplish this purpose by generating a numerical representation (a "digest") for the combined subject line and message content (*Hockey*, paragraph 96) and comparing the resulting digest with existing digests stored in memory (*Hockey*, paragraph 102). The *Hockey* system creates and compares the mathematical digest from an electronic mail message ("email") with other stored digests because analyzing the textual content of the email would fail to prevent dissemination of certain viruses and spam – the purpose of the *Hockey* system. Viruses, such as email worms, and spam generally do not contain content that would be deemed inappropriate by a monitor or filter. As set forth in *Hockey*, email worms generally contain malicious code (which would be undetectable to a monitor analyzing textual content), but otherwise "comprise a suitably benign message as further means of deception to

the recipients.” *Hockey*, paragraph 6 (emphasis added). Thus, the ability to monitor and/or remove inappropriate content based on textual content as described in *Matthews* would have no effect on identifying the emails that the *Hockey* system attempts to prevent. That is, *Hockey* states that monitoring the textual content of certain emails that contain viruses or spam would be useless with respect to the purpose of the *Hockey* system. See *Hockey*, paragraphs 5-12. In fact, *Hockey* both distinguishes and teaches away from systems wherein communications are filtered based on character strings that the recipient desires not to receive. *Hockey*, paragraph 11. That is, *Hockey* specifically distinguishes systems, such as the one described in *Matthews*, on the basis that monitoring textual content is ineffective to protect against spam and virus attacks, such as email worms.

Thus, combining the ability to monitor and/or remove inappropriate content described in *Matthews* with the quarantining of messages based on comparing a digest of the message with other stored digests described in *Hockey* would: (1) render the filtering system disclosed by *Hockey* inoperable and useless for its intended purpose, and (2) would fail to flag any messages based on inappropriate content for the purpose described in *Matthews*. A system that combines elements of the *Matthews* system and the *Hockey* system described above would result in a system that would fail for both the purpose of the *Matthews* system and the purpose of the *Hockey* system. Thus, there is no “reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does.” See *KSR*, 127 S. Ct. at 1741. Importantly, *Hockey* distinguishes and teaches away from monitoring and/or removing messages based on content, which is the portion of *Matthews* the Examiner desired to combine with *Hockey*.

Since *Hockey* teaches away from *Matthews*, there is nothing to prompt a person of ordinary skill to combine the elements found in *Hockey* and *Matthews*. Importantly, combining the relevant elements of *Hockey* and *Matthews* would defeat the purposes of both *Hockey* and *Matthews* and render the combined system inoperable. Thus, the present limitation is not obvious in light of *Matthews* in view of *Hockey*. Accordingly, the combination of *Hockey* and *Matthews* is unable to rectify the deficiencies of *Matthews* alone with respect to the current limitation.

III. Conclusion

For the reasons stated above, claims 2 and 12 are not obvious in view of *Matthews*, *Sutcliffe*, and *Hockey*. The remaining claims depend from these independent claims, recite further limitations, and are therefore allowable in their respective combinations. Favorable action by the Examiner and withdrawal of the cited rejections is respectfully requested. The Examiner is invited to call the undersigned in an effort to discuss and resolve any remaining issues.

Respectfully submitted,

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